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**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA**

HDMI LICENSING ADMINISTRATOR, INC.,

Plaintiff,

v.

AVAILINK INC.

Defendant.

CASE NO.: 4:22-cv-06947-HSG

**MOTION TO RESCHEDULE CASE
MANAGEMENT CONFERENCE AND
HEARING ON MOTION TO DISMISS
PURSUANT TO LOCAL RULE 6-3**

Complaint Filed: November 7, 2022

TO THE COURT, ALL PARTIES, AND THEIR ATTORNEYS OF RECORD:

Pursuant to Civil Local Rule 6-3, Plaintiff HDMI Licensing Administrator, Inc. (“Plaintiff” or “HDMI LA”), through its counsel of record, hereby moves this Court to reschedule the Initial Case Management Conference (the “CMC”) and hearing on Defendant Availink Inc.’s (“Defendant” or “Availink”) pending motion to dismiss (*Dkt. No. 30*) (the “MTD”). Specifically, Plaintiff requests that the CMC and MTD, which is fully briefed, be reset for hearing to the next available date of December 14, 2023, or until a date that suits the Court sometime after November 13, 2023 (the date on which Plaintiff’s planned motion to dismiss Defendant’s counterclaims will be fully briefed). This will allow the MTD to be heard on the same date as Plaintiff’s planned motion to dismiss Defendant’s counterclaims, which will conserve the time and resources of the parties, as well as this Court, and allow the Court to consider interrelated issues at once. Plaintiff attempted to obtain a stipulation to reschedule the hearing, but Defendant does not agree. As set forth herein, there is good cause for Plaintiff’s request.

A. BRIEF FACTUAL AND PROCEDURAL BACKGROUND**1. Defendant’s MTD Is Fully Briefed**

On November 7 2022, Plaintiff filed its Complaint (*Dkt. No. 1*). Defendant agreed to waive formal service of the Summons and Complaint, thereby making April 12, 2023 its deadline to respond to the Complaint. *See* Declaration of Kerry Brownlee (“Brownlee Decl.”), ¶ 3. The CMC was originally set for February 14, 2023 (*Dkt. No. 11*), and the parties sought a first adjournment thereof, given that Defendant had not yet retained local counsel, and the parties were in discussions regarding whether or not the dispute could be resolved among them (*Dkt. No. 13*). The Court granted the parties’ request, and adjourned the CMC to April 25, 2023 (*Dkt. No. 15*).

On April 12, 2023, Defendant filed its partial MTD, which seeks dismissal of Counts II-IV of the Complaint (Plaintiff’s claims for direct trademark infringement, contributory trademark infringement, and federal unfair competition) (*Dkt. No. 30*). Thereafter, on April 25, 2023, the Court held a telephonic hearing wherein it continued the CMC until the hearing date on Defendant’s MTD (July 20, 2023) (*Dkt. No. 39*). On April 26, 2023 Plaintiff filed its opposition to Defendant’s MTD (*Dkt. No. 38*), and on May 3, 2023, Defendant filed its reply (*Dkt. No. 40*).

2. The Parties Stipulate to Adjourn the CMC and MTD Hearing To Complete Mediation

On May 12, 2023, the parties filed a second stipulated request to adjourn the CMC and hearing on Defendant's MTD until July 27, 2023 (*Dkt. No. 43*) in order to permit the parties time to complete their in-person mediation, scheduled for July 12, 2023, and such stipulation was granted by the Court. The parties then participated in an in-person mediation on July 12, 2023 in San Jose, California before John Bates, Esq. (the "Mediator"), after which Plaintiff agreed to discuss the terms of Defendant's settlement proposal internally, and with potentially affected parties, at an upcoming meeting on August 8, 2023. Brownlee Decl., ¶ 8.

In order to permit the parties additional time to explore if settlement was possible before the CMC, and for the August 8, 2023 meeting to occur, the parties filed a third joint stipulated request to extend the CMC and hearing on Defendant's MTD to October 12, 2023. Brownlee Decl., ¶ 9.

On August 22, 2023, the parties had a follow-up call among counsel and the Mediator to further discuss the prospect of settlement and during which Plaintiff set forth a counter offer. Brownlee Decl., ¶ 10. On August 23, 2023, Defendant rejected Plaintiff's counter offer, and it became clear that the parties are at an impasse regarding settlement. *Id.* at ¶ 11.

3. Defendant's Counterclaims and Plaintiff's Anticipated Motion to Dismiss

On September 1, 2023, right before the Labor Day holiday, Defendant filed an Answer and Counterclaims against Plaintiff (*Dkt. No. 49*) (the "Counterclaims"). On September 13, 2023, the parties filed a stipulated request to extend Plaintiff's deadline to respond to Defendant's Counterclaims until October 23, 2023 (*Dkt. 50*), which was granted by the Court (*Dkt. No. 51*).

After conferring further with its counsel, and additional co-counsel specializing in antitrust matters, Plaintiff decided that it is going to move to dismiss the Counterclaims, and informed Defendant's counsel as such via email on September 18, 2023. Brownlee Decl., ¶ 14.

4. Plaintiff Attempted to Obtain A Stipulation to Reschedule

In Plaintiff's counsel's September 18, 2023 email, Plaintiff's counsel informed Defendant's counsel, Vincent Filardo, Jr., of Plaintiff's plan to file a motion to dismiss (the "Anticipated Motion to Dismiss"), and asked if Defendant would consent to an adjournment of the CMC and hearing on Defendant's MTD until after Plaintiff's Anticipated Motion to Dismiss is fully briefed on November

1 13, 2023, and advised Defendant's counsel of the next available law and motion date on the Court's
2 calendar (December 14, 2023). Brownlee Decl., ¶ 15.

3 On September 19, 2023, Defendant's counsel advised, in relevant part, as follows: "[a]t this
4 juncture the hearing on the MTD and CMC will be delayed for nearly 3 months. HDMI's putative
5 motion to dismiss Availink's Counterclaims is not a reasonable basis to further delay the proceedings
6 and the requested delay is not supported by federal practice and procedure. Availink disagrees that it is
7 necessary or would be efficient to further postpone the MTD hearing and CMC in light of that yet to be
8 filed motion. Availink will not consent to any further adjournments." Brownlee Decl., ¶ 16.

9 On September 19, 2023, Plaintiff's counsel responded to Defendant's counsel's various
10 contentions, and indicated, in relevant part as follows: "in Count II of Availink's Counterclaims, it
11 includes a claim for cancellation of U.S. Trademark registrations 3,268,924 and 3,442,135. The MTD
12 seeks dismissal of HDMI LA's direct and contributory trademark claims. Under 15 U.S.C. § 1119, a
13 party only may seek cancellation '[i]n any action involving a registered mark'. Therefore, to the extent
14 that Availink's MTD is successful, that could have the potential to impact Availink's standing to bring
15 Count II. *See San Diego Cty. Credit Union v. Citizens Equity First Credit Union*, 2020 U.S. Dist.
16 LEXIS 179341 (S.[D]. Cal. September 29, 2020)." Brownlee Decl., ¶ 17. In Plaintiff's counsel's email
17 of September 19, 2023, she also indicated that HDMI LA would proceed by way of a motion to
18 reschedule, given that Defendant does not consent to the request sought herein. *Id.* at ¶ 18.

19 **B. THERE IS GOOD CAUSE TO CONTINUE THE CMC AND MTD HEARING TO THE**
20 **SAME DATE AS PLAINTIFF'S ANTICIPATED MOTION TO DISMISS**

21 In light of the foregoing, and for the sake of efficiency, among other things, HDMI LA believes
22 that it is most practicable for the Court to consider all of the issues together at one hearing. While
23 Availink has indicated it disagrees that it is necessary or would be efficient to further postpone the
24 MTD hearing and CMC due to Plaintiff's Anticipated Motion to Dismiss, it has not provided any
25 factual basis in support of the proposition that holding a hearing on October 12, 2023 on the MTD, and
26 then a second hearing in or about December 2023 on Plaintiff's Anticipated Motion to Dismiss would
27 be the best use of the parties' and Court's time and resources." *See* Brownlee Decl., ¶ 17.

1 Given the above, and that this Court's decision on Defendant's MTD has the capacity to impact
 2 the Counterclaims, and it would be more efficient for all issues to be heard at one hearing, rather than
 3 two, Plaintiff respectfully submits that there is just cause for its rescheduling request. Holding two in-
 4 person hearings, rather than one, would needlessly drive up the costs for both parties, both of which, in
 5 addition to local counsel, have counsel located outside of the State of California. Plaintiff's proposal
 6 would conserve the resources of the parties, as well as this Court. Plaintiff's rescheduling request will
 7 not impact any other deadlines, other than the parties' deadline to submit their updated case
 8 management statement. Brownlee Decl., ¶ 19.

9
 10 DATED: September 20, 2023

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CERTIFICATE OF SERVICE

I hereby certify the on September 20, 2023, I electronically filed the foregoing document using the CM/ECF system, which will send notification of such filing to the email addresses registered in the CM/ECF system.

DATED: September 20, 2023

By: s/ Kerry B. Brownlee
Kerry B. Brownlee
Epstein Drangel LLP

Attorneys for Plaintiff
HDMI Licensing Administrator, Inc.